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REMARKS

Claims 1-25, 27 and 31-36 (along with any rejoined portions of claims 28-30 as stated in Applicant's response of March 18, 2004) are pending in the case. The Examiner states that claims 28 and 30 are withdrawn from consideration; however, on page 5 of the Office Action of December 15, 2003, the Examiner stated: "Process claims that depend from or otherwise include all of the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier." Claims 28 and 30 depend on the amended product claim 1 and thus, Applicant believes that they will be rejoined with the claims under prosecution. Thus, this Response includes claims 28 and 30.

In the present Office Action, claims 1-25, 27 and 36 stand rejected. Claims 31-35 stand allowed.

Claims 1-25, 27 and 36 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly "enablement" reasons. The Examiner states that the specification, while being enabling for compounds in table 1 and in the specification examples 1-110, does not "reasonably provide enablement for all the compounds presented by the general structure formula of claim 1". Page 2 of the instant Office Action. The Examiner cites the "need" for "undue experimentation" as the reason. This rejection is respectfully traversed.

Applicants, as the Examiner has pointed out, have disclosed in this case a number and variety of compounds, by experimentation, activity data and individual structures, which all fall within the general structure of formula I. Applicants believe that such an enormous and substantial amount of disclosure satisfies the enablement requirement quite well. "The law does not require the impossible. Hence, it does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention. The law recognizes that patent specifications are written for those *skilled in the art*, and requires only that the inventor describe the "best mode" known at the time to him of making and using the invention." 35 U.S.C. § 112. There is a well-documented legal precedent to support Applicants' assertion that the enablement requirement is fully satisfied in the present case. "To be enabling under § 112, a patent must contain a description that enables one skilled in the art to make and use the claimed invention." *Atlas Powder Co. v.*

E.I. duPont De Nemours & Co., 750 F.2d 1569, 1576, 224 U.S.P.Q. (BNA) 409, 413 (Fed. Cir. 1984). "It is well established that a patent applicant is entitled to claim his invention generically, when he describes it sufficiently to meet the requirements of Section 112." *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.,*, 18 U.S.P.Q.2d (BNA) 1016, 1027 (Fed. Cir. 1991). "[I]t is not necessary that a patent applicant test all the embodiments of his invention" *In re Angstadt*, 537 F.2d 498, 502, 190 U.S.P.Q. (BNA) 214, 218 (CCPA 1976). Applicants believe that the vast amount of details, compounds, variety of molecules and particulars that are provided in the present case are sufficient enough to fully satisfy the enablement requirement, and, therefore, respectfully request withdrawal of the § 112, first paragraph rejection.

Claims 1-24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/908,955. The Examiner states: "when in general formula (I) of claim 1 of present application W and Q are missing (page 366) and in the general formula (I) of claim 1of application 09/908,955 W and M are missing, the two claims and their subsequent dependent claims are identical in scope". Pages 7-8 of the present Office Action. Applicants respectfully disagree with this conclusion for the following reasons:

In the general formula (I) of the present application: When Q is absent, M is also absent, and A is directly linked to X (see Claim 1). In that case, when both W and Q are absent, we still get a macrocycle linking the parts marked Z-Y-X-A-E-G-(carbon)-N-C(=O)-(carbon).

In the general formula (I) of the application 09/908,955: W is linked on the one side with Z and on the other side to Y, and when W and M are missing, Y will be linked to Z, but the ring (containing Q-A-E etc) is not going to be part of that link Y-Z. The resulting compounds in the two instances will be quite different. Applicants believe that there is no identity-of-scope in this situation and, therefore, respectfully request withdrawal of the obviousness-type double patenting rejection.

Claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/013,071. Depending on the finally allowed

claims, Applicants are willing to consider filing a terminal disclaimer of any "identical-in-scope" claim elements.

There being no other rejections pending, Applicant believes that claims 1-25, 27 and 31-36, along with any rejoined portions of claims 28-30, are in allowable condition. Such an action is earnestly requested. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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Respectfully submitted,

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